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Jay S. Walker

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EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

3696

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/654,933	Applicant(s) WALKER ET AL.	
	Examiner Ella Colbert	Art Unit 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-62, 70 and 74-80 is/are pending in the application.
- 4a) Of the above claim(s) 70 and 74-79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-62 and 80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 49-62, 70, 74-79, and 80 are pending in this communication filed 04/22/09 entered as Response to Election/Restriction and Request for Extension of time. Invention I, Claims 49-62 were elected with traverse in response to the Election/Restriction. Claims 49-62 and 80 will be examined in this communication as set forth here below. The Arguments with traverse will be responded to in the section of this communication entitled "Response to Arguments with Traverse".

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 49, 51-55, 58-62, and 80 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 49 recites, "determining a first value" and "determining a second value". It is unclear and vague how the first and second value is determined. The usage of the term "determining" is broad and varied. By definition "determining" is defined as: 1a. To decide or settle (a dispute, for example) conclusively and authoritatively. B. To end or decide, as by judicial action. 2. To establish or ascertain definitely, as after investigation or calculation; To reach a decision; resolve". Claims 61, 62, and 80 have a similar issue.

Claim 49 also contains a conditional statement. There is not any step to lead one to know what happens if the customer fails to agree to the modification of the

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parameter. Is the customer made another offer? Claims 61, 62, and 80 have a similar issue (See Office Action mailed 06/30/06).

Claim 49 recites “first value”, “second value”, and “parameter”. One of ordinary skill in the financial arts would be hard put to identify a “first value”, “a second value”, and a “parameter”. Such “values” and “parameters” are broad, varied and constantly changing. Claims 51-55, 58-62, and 80 have a similar issue (See Office Action mailed 06/30/06).

Independent claims 49 and 62 reciting “determining a first value for a parameter of a credit account; determining a second value for the parameter” is interpreted very broadly. The usage of the terms “value” and “parameter” are considered to be indefinite because no “value amount” is given and a value by definition is “a fair return or equivalent in goods, services, or money for something exchanged, the monetary worth of something: marketable price” and “parameter” in its broadest sense is defined as “an arbitrary constant whose value characterizes a member of a system or an independent variable used to express the coordinates of a variable point and functions of them or any of a set of physical properties whose values determine the characteristics or behavior of something”.

Claim 80 recites “receiving an indication that the customer agrees to the modification”. It is vague and indefinite as to what Applicants’ mean by “an indication”. It cannot be determined from the claim language how or what the indication is to show that the customer agrees to the modification. Does the customer say “yes” or sign a form or give some type of gesture?

The dependent claims 50, 56, and 57 are also rejected for their dependency from a rejected base claim.

USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550- 551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 62 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claim 62 fails to meet the above requirements since there is not a sufficient tie to another statutory class. Unless the encoded program is computer executable this claim does not qualify as statutory eligible subject matter under 35 USC 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 49, 50, and 62 are rejected under 35 U.S.C. 102(b) as being anticipated by "American Express launches new Optima card strategy", Paul Deckelman, hereafter Deckleman.

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Claims 49 and 62: A method and a medium encoded with a program for implementing a method , comprising: determining a first value for an parameter of a credit account (pg. 44, para. 7-The first value is 12.5 per cent) the second value is 17.4 percent); determining a second value for the parameter (pg. 44, para. 8- the second value is 17.4 per cent); calculating a payment, wherein the payment is based on a modification of the parameter from the first value to the second value (pg. 44, para. 9- the calculation is based on \$1,000 annually being spent); and providing an offer to a customer associated with the credit account, wherein the offer comprises an offer to provide the payment to the customer if the customer agrees to the modification of the parameter (pg. 45, para. 6- when a package (credit account) is offered to the customer and the customer agrees by receiving the offer of the interest rate).

Claim 50. The method of claim 49, further comprising: receiving a customer acceptance of the offer (pg. 45, para. 7- It is considered inherent that the customer would accept an offer of a lower rate).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over "American Express launches new Optima card strategy", Paul Deckelman, hereafter Deckleman in view of (US 5,297,026) Hoffman.

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Claim 51. Deckelman discloses, The method of claim 50, further comprising: providing the payment to the customer (pg. 45, para. 7- when the package is offered to the customer and the customer accepts the offer the payment is made to the customer); and modifying the account parameter from the first value to the second value (pg. 44, para. 6-para. 9- The first value is 12.5 per cent and the modified value is 17.4 per cent).

Claim 52. Deckelman failed to disclose, The method of claim 51, wherein an indication of the first value of the parameter of the credit account associated with the customer is stored in a record of a parameter database and where the step of modifying the parameter comprises: substituting the second value for the first value in the record of the parameter database. Hoffman discloses, wherein an indication of the first value of the parameter of the credit account associated with the customer is stored in a record of a parameter database and where the step of modifying the parameter comprises: substituting the second value for the first value in the record of the parameter database (col. 7, line 1-col. 8, line 50 and figs. 3-4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Deckelman with the teachings of Hoffman because such a modification would allow Deckelman to have a database for his first value and second value and the calculation of the amount being spent annually.

Claim 53. Deckelman failed to disclose, The method of claim 52, wherein the value of the parameter as stored in the record of the parameter database is used to calculate an amount owed by the customer for activity on the credit account. Hoffman discloses, wherein the value of the parameter as stored in the record of the parameter database is

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used to calculate an amount owed by the customer for activity on the credit account (col. 7, line 1-col. 8, line 36 and fig. 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Deckelman with the teachings of Hoffman because such a modification would allow Deckelman to have a database for his first value and second value and the calculation of the amount being spent annually.

Claims 54-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over "American Express launches new Optima card strategy", Paul Deckelman, hereafter Deckelman in view of (US 5,297,026) Hoffman as applied to claims 49-53 above, and further in view of "Developments in the pricing of credit card services"; Canner, Glenn B.; Luckett, Charles A.; Cook, Wayne C.; and Peirce, Mark A., hereafter Canner et al. and (WO 00/60487) Wilcox.

Claim 54. Deckelman and Hoffman failed to disclose, The method of claim 49, wherein the account parameter comprises one of an interest rate, a time period of the interest rate, a monthly minimum payment, a credit limit, a grace period, a payment amnesty, and a late fee. Canner et al discloses, wherein the account parameter comprises one of an interest rate, a time period of the interest rate, a monthly minimum payment, a credit limit, a grace period, a payment amnesty, and a late fee (pg. 26, para. 4 –"grace period of twenty to thirty days"), pg. 35, para. 2-"grace period", pg. 28, para. 2 –variable rate plans and interest rates, and pg. 30, para. 2 (credit line)). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Deckelman with the teachings of Canner et al because such a modification

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would allow Deckelman to have an interest free “grace period” and a lower rate on a credit account. The type of information is given very little patentable weight because it is considered “non functional descriptive material that cannot render nonobvious an invention that would have otherwise been obvious”. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ 2d, 1862, 1864 (Fed. Cir. 2004). *In re Gulak*, 703 F.2d 1381, 1385, 217 USPQ401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Statements of intended use do not serve to distinguish structure over the prior art. See *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974); *In re Yanush*, 4778 F.2d 958, 959, 152 USPQ 235, 238 (CCPA 1967).

Claim 55. Deckelman, Hoffman, and Canner et al failed to disclose, The method of claim 49, wherein the second value is selected based on information associated with the customer associated with the credit account. Wilcox discloses, wherein the second value is selected based on information associated with the customer associated with the credit account (pg. 4, lines 6-20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Deckelman with the teachings of Wilcox because such a modification would allow Deckelman to have access to the credit worthiness of a customer to determine whether the customer is in good standing on a credit account.

Claim 56. Deckelman, Hoffman, and Canner et al failed to disclose, The method of claim 55, wherein the customer information comprises a customer rating. Wilcox

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discloses, wherein the customer information comprises a customer rating (pg. 8, lines 5-8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Deckelman with the teachings of Wilcox because such a modification would allow Deckelman to have access to the credit worthiness of a customer to determine whether the customer is in good standing on a credit account.

Claim 57. Deckelman, Hoffman, and Canner et al failed to disclose, The method of claim 56, wherein the customer rating is based on at least one of a past payment history for the credit account, information obtained from a credit reporting agency, and an income of the customer. Wilcox discloses, wherein the customer rating is based on at least one of a past payment history for the credit account, information obtained from a credit reporting agency, and an income of the customer (pg. 7, lines 9-13 and line 24-pg. 8, line 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Deckelman with the teachings of Wilcox because such a modification would allow Deckelman to have information used to determine and individual's creditworthiness which is well known in the credit granting industry.

Claim 58. Deckelman discloses, The method of claim 49, wherein the step of calculating the payment comprises: calculating a payment, wherein the payment is based on the modification of the parameter from the first value to the second value and information associated with the customer associated with the credit account (pg. 44, para. 9).

Claim 59. Deckelman discloses, The method of claim 49, wherein the second value of the parameter is more favorable to a credit account issuer associated with the credit account (pg. 45, para. 6).

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Claim 60. Deckelman discloses, The method of claim 49, wherein the second value of the parameter is more profitable to a credit account issuer associated with the credit account (pg. 45, para. 6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,297,026) Hoffman in view of Deckelman.

Claim 61. Hoffman discloses, A storage device (col. 3, line 15); a processor in communication with the storage device, the storage device storing a program for controlling the processor; and the processor operative with the program (col. 3, lines 15-25 and line 65-col. 4, line 2):

Hoffman failed to disclose, determine a first value for a parameter of a credit account; determine a second value for the parameter; calculate a payment, wherein the payment is based on a modification of the parameter from the first value to the second value; and provide an offer to a customer associated with the credit account, wherein the offer comprises an offer to provide the payment to the customer if the customer agrees to the modification of the parameter. Deckelman discloses, determine a first value for a parameter of a credit account (pg. 44, para. 7-The first value is 12.5 per cent) the second value is 17.4 percent); determine a second value for the parameter

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(pg. 44, para. 8- the second value is 17.4 per cent); calculate a payment, wherein the payment is based on a modification of the parameter from the first value to the second value (pg. 44, para. 9- the calculation is based on \$1,000 annually being spent); and provide an offer to a customer associated with the credit account, wherein the offer comprises an offer to provide the payment to the customer if the customer agrees to the modification of the parameter (pg. 45, para. 6- when a package (credit account) is offered to the customer and the customer agrees by receiving the offer of the interest rate). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hoffman with the teachings of Deckelman because such a modification would allow Hoffman to have different interest rates for customers with good and bad credit payment histories.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 80 is rejected under 35 U.S.C. 103(a) as being unpatentable over Deckelman in view of (US 5,297,026) Hoffman.

Claim 80. Deckelman discloses, A method, comprising:

determining a current value for a parameter of an existing credit account, in which the existing credit account is associated with a customer (pg. 44, para. 7-a current value is 12.5 per cent); determining a value for the parameter that is not the same as the current

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value (pg. 44, para. 8- the value is 17.4 percent); calculating, by a processing device, a payment (pg. 44, para. 9- the calculation is based on \$1,000 annually being spent); providing an offer to the customer, in which the offer comprises an offer to provide the payment to the customer if the customer agrees to a modification of the parameter from the current value to the value that is not the same as the current value (pg. 45, para. 6- when a package (credit account) is offered to the customer and the customer agrees by receiving the offer of the interest rate).

Deckelman failed to disclose, receiving an indication that the customer agrees to the modification; and providing the payment to the customer after receiving the indication. Hoffman discloses, receiving an indication that the customer agrees to the modification (col. 3, lines 53-61); and providing the payment to the customer after receiving the indication (col. 4, lines 3-11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Deckelman with the teachings of Hoffman because such a modification would allow Deckelman to have an incentive to offer credit card customers for the purchase of goods and services if they are in good standing with the use of their credit cards. However, it is obvious that a person if the person agrees to a modification of an account to give some type of indication that they are in agreement.

Answer to Arguments With Traverse

MPEP 821.01 Election With Traverse

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¶ 8.25 Answer to Arguments With Traverse

Applicant's election with traverse of Group I, Claims 49-62 in the reply filed on 04/22/09 is acknowledged.

The traversal is on the ground(s) that Invention I, claims 49-62 are elected for examination with traverse because No prima facie case establishing a requirement of restriction. Applicants traverse the restriction requirement provided in the present Office Action because the Office Action fails to provide a prima facie case that restriction is appropriate. The conclusion that restriction is appropriate is not supported by substantial evidence or by an articulated explanation in light of any such evidence.

Specifically, there is no evidence offered in support of the finding that subsets of the claims (the alleged "inventions") differ from one another so significantly that they are "unrelated." To the contrary, findings in the Office Action (e.g., with respect to the search classifications for the subject matter) contradict a finding that the claims address "inventions" that are "unrelated." Further, there is no evidence or explanation provided that would support the mere conclusion that examination of all of the pending claims would be a serious burden.

2.01. Findings by the Office

The Office Action states that Invention I is classified in class 705, subclass 35; Invention II is classified in class 705, subclass 77; and Invention III is classified in class 705, subclass 39. [Office Action page 2]. The Office Action thus finds that all of the claimed subject matter is generally defined under class 705.

The Office Action states:

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation and effects (MPEP § 802.01 and § 8-6.06). In the instant case, the different inventions have different scopes, furthermore they have different modes of operation thus yielding different results and are not capable of use together for the reason set forth.

[Office Action, page 3].

The Office Action further finds that there would be a serious search and examination burden if restriction were not required because one or more of five identified reasons apply. [Office Action, page 3]. The Office Action does not, however, indicate any particular one (or more) reason, nor does it provide any explanation or evidence in support of any of the listed reasons.

According to the Manual for Patent Classification (accessible at <http://www.uspto.gov/web/patent/s/classification/>):

This [class 705] is the generic class for apparatus and corresponding methods for performing data processing operations, in which there is a significant change in the data or for performing calculation operations wherein the apparatus or method is uniquely designed for or utilized in the practice, administration, or management of an enterprise, or in the processing of financial data.

This class also provides for apparatus and corresponding methods for performing data processing or calculating operations in which a charge for goods or services is determined.

This class additionally provides for subject matter described in the two paragraphs above in combination with cryptographic apparatus or method.

SCOPE OF THE CLASS

1. The arrangements in this class are generally used for problems relating to administration of an organization, commodities or financial transactions.

2. Mere designation of an arrangement as a "business machine" or a document as a "business form" or "business chart" without any particular business function will not cause classification in this class or its subclasses.

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3. For classification herein, there must be significant claim recitation of the data processing system or calculating computer and only nominal claim recitation of any external art environment. Significantly claimed apparatus external to this class, claimed in combination with apparatus under the class definition, which perform data processing or calculation operations are classified in the class appropriate to the external device unless specifically excluded therefrom.

4. Nominally claimed apparatus external to this class in combination with apparatus under the class definition is classified in this class unless provided for in the appropriate external class.

5. In view of the nature of the subject matter included herein, consideration of the classification schedule for the diverse art or environment is necessary for proper search.

Subclass 35 ("Finance (e.g., banking, investment or credit)" is directed to subject matter drawn to a computerized arrangement for planning the disposition or use of funds or securities, or extension of credit. Subclass 35 is indented under subclass 1 ("Automated electrical financial or business practice or management arrangement"), which is directed to subject matter wherein an electrical apparatus and its corresponding methods perform the data processing operations, in which there is a significant change in the data or for performing calculation operations wherein the apparatus or method is uniquely designed for or utilized in the practice, administration, or management of an enterprise, or in the processing of financial data.

Subclass 39 ("Including funds transfer or credit transaction") is directed to subject matter drawn to a computerized arrangement for transferring funds by debiting one account and crediting another by the same amount. Subclass 39 is indented under subclass 35, discussed above.

Subclass 77 ("including remote charge determination or related payment system") is directed to subject matter wherein the determination at a remote vendor site of a payment due or a transfer of funds from a buyer to a remote vendor. Subclass 77 is indented under subclass 64 ("secure transaction (e.g., EFT/POS)"), which is directed to subject matter wherein an exchange of financial data is protected by encryption. Subclass 64 is indented under subclass 50 ("Business processing using cryptography") which is directed to subject matter including cryptographic apparatus or methods uniquely designed for or utilized in the practice, administration, or management of an enterprise, the processing of financial data, or where a charge for goods or services is determined. [Subclass 50 explicitly excludes "subject matter related to business processing having only nominal recitation of cryptographic processing such as encrypting, scrambling, etc.

Such nominal recitation of cryptography combined with business processing is classified elsewhere."]

A search on April 22, 2009 of the USPTO Patent Full-text and Image Database (accessible at patft.uspto.gov) for patents classified in both 705/35 and 705/39 yielded 296 issued patents.

A search on April 22, 2009 of the USPTO Patent Full-text and Image Database (accessible at patft.uspto.gov) for patents classified in both 705/35 and 705/77 yielded 23 issued patents.

A search on April 22, 2009 of the USPTO Patent Full-text and Image Database (accessible at patft.uspto.gov) for patents classified in both 705/39 and 705/77 yielded 31 issued patents.

The Office Action does not Meet the Prima Facie Burden for a Holding of "Independent" (i.e. "Unrelated") Inventions

The prima facie burden for establishing that claimed subject matter is appropriately restricted as being directed to "independent" (i.e. "unrelated") inventions has not been met.

The Office Action holds that there are multiple inventions claimed that are "unrelated." [Office Action, page 3]. A finding that alleged inventions are "unrelated" is a finding of "independence" of the inventions. See MPEP § 802.01 ("Independent", of course, means not dependent>, or unrelated").

The term "independent" (i.e., unrelated) means that there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect. For example, a process and an apparatus incapable of being used in practicing the process are independent inventions. MPEP § 802.01.

Per MPEP § 808.01: The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

The Office Action fails the requirement of MPEP § 808.01 to provide any particular reasons for holding that there are multiple inventions claimed that are independent (i.e. "unrelated"). The statement on page 3

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(cited above) is a mere statement of conclusion, and therefore inadequate. That the allegedly "different inventions" are different in scope is irrelevant and insufficient; claims must differ in scope from one another. The statement as to "different modes of operation" is conclusory; no reasoning or explanation is given. The statement as to "yielding different effects" is conclusory; no reasoning or explanation is given. And again, claims must differ in scope to be allowable. Accordingly, difference in scope, alone, cannot be the appropriate basis for a finding of a "different mode of operation" or "different effect."

The statement as to "not capable of use together for the reason set forth" is conclusory and erroneous. There is no reasoning as to why the various claimed subject matter would be incapable of use together, even if it were established (which it has not been) that various aspects yield different effects and have different modes of operation. Also, the test for independence requires that the subject matter is not disclosed as being capable of use together; the Office Action appears to ignore this requirement and makes no finding about how the subject matter is disclosed.

In contrast to the Office Action's conclusory and inadequate finding of independence, MPEP § 806.06 provides guidance, by example, of inventions that are claimed as independent (i.e. unrelated) (emphasis added): Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions and different effects are independent. An article of apparel and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example.

Applicants respectfully submit that any differences among the pending claims are not so extreme as those evident in comparing an article of apparel with a locomotive bearing, or a process of painting with a process of boring a well. Clearly, where all currently claimed embodiments are generally directed to processing related to credit accounts, no such independence exists.

Further, the Office Action's own finding that the subject matter is all classified in Class 705 (with which Applicants do not necessarily agree or disagree) contradicts the conclusory finding of independence of the alleged inventions. The finding that an invention classified in 705/35 is somehow "unrelated" to one classified in 705/39 seems particularly inappropriate, given the hierarchical relationship and commonalities among those classifications (see the search results above).

The Office Action does not Meet the Prima Facie Burden for Establishing a Serious Search and Examination Burden

As noted above, the Office Action does not actually provide a specific reason, much less provide a rationale, as to why examination of all the claims would be a serious burden. The task of specificity in the reasoning means that no prima facie case has been made, much less one supported by substantial evidence.

This is not found persuasive because Invention II, Claims 70 and 74-79 do not even remotely claim the same subject matter as Invention I, claims 49-62 and 80. Invention II is directed toward determining whether a customer is dissatisfied with a credit account and making an offer to the customer to modify a term of the credit account with the offer being a payment. Invention I, Claims 49-62 and 80 are directed to determining a first value and a second value, calculating a payment with the payment being a modification of a parameter, and providing an offer to the customer of the credit account to make a

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payment if the customer agrees to the modification of the parameter. These are two inventions are distinctly different from each other. Sufficient evidence is considered to have been given by the Examiner.

Furthermore, the Examiner consulted with the Supervisor regarding the restriction and this was the decision that was made regarding the restriction.

The requirement is still deemed proper and is therefore made FINAL.

¶ 8.05 Claims Stand Withdrawn With Traverse

Claims 70 and 74-79 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 04/22/09.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McCauley et al (US 5,930, 775) disclosed real estate loans and the ability-to-pay rate.

Marsha Kay Seff, "Pre-approved plastic provides punch for purchasing a home" disclosed a credit limit and a 60-day interest-rate guarantee.

Debra Fowler, "Consumers lose their way in blizzard of credit card offers" disclosed interest rates, percent of interest, fixed rate interest, and no-annual-fees on a credit card.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

July 30, 2009